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S&H Form: (2/01)

Docket No.: 1793.1054

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Bu-Hyun Sung et al.

Serial No: 10/736,842

Group Art Unit: 2832

Confirmation No. 5433

Filed: December 17, 2003

Examiner: Bernard Rojas

For: SOLENOID SWITCH AND PLATING METHOD THEREOF

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed July 12, 2005, having a shortened period for response set to expire on August 12, 2005, the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect Group I (claims 1-5) in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

Insofar as Group II (claims 6-10) and Group III (claim 11) are concerned, it is believed that claims 6-11 are so closely related to elected claims 1-5 that they should remain in the same application. The elected claims 1-5 are directed to a solenoid switch comprising an anti-corrosion material being thinner on the first surface than on the second surface and claims 6-10 are drawn to a method of plating a solenoid comprising plating the frame and the moving part with a first anti-corrosion material having a first thickness and re-plating the frame and the moving part with a second anti-corrosion material having a second thickness. Claim 11 is directed to an apparatus comprising a solenoid switch wherein a thickness of the anti-corrosion material is thinner at the contact surfaces than at the non-contact surfaces of the frame and the moving part. There have been no references cited to show any necessity for requiring restriction. It is believed, moreover, that evaluation of all sets of claims would not provide an

undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the Group II and III claims by filing a divisional application.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden if restriction is required.

Even if the Examiner considers claims 1-5 to be a separate invention from claims 6-11, the Applicants respectfully request the Examiner to consider claims 1-5 (Group I) and claims 6-11 (Groups II and III) together.

III. Conclusion

Upon review of references involved in this field of technology, when considering that the Group II claims are directed to a method of plating a solenoid comprising plating the frame and the moving part with a first anti-corrosion material having a first thickness and re-plating the frame and the moving part with a second anti-corrosion material having a second thickness, the group III claim is directed to an apparatus comprising a solenoid switch wherein a thickness of the anti-corrosion material is thinner at the contact surfaces than at the non-contact surfaces of the frame and the moving part, and elected claims 1-5 are directed to a solenoid switch comprising an anti-corrosion material being thinner on the first surface than on the second surface, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

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Date: 8-11-05

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